

REMARKS

Applicant has carefully studied the Office Action of April 28, 2004 and offers the following remarks in response thereto.

Claims 1-31 were rejected under 35 U.S.C. § 102(a) as being anticipated by Holdrege et al. (hereinafter “Holdrege”). Applicant respectfully traverses. For the Patent Office to prove anticipation, the reference must show each and every claim element recited in the claims. Further, the elements of the reference must be arranged as claimed. MPEP § 2131. Further, the reference must be enabling. MPEP § 2121. To be enabling, someone of ordinary skill in the art must be able to combine the publication’s description of the invention with his own knowledge to make the claimed invention. MPEP § 2121.01. If the reference is not enabling, it is improper to rely on the reference in an anticipation analysis.

Applicant initially notes that the physical page breaks of the document do not correspond to the denoted page breaks of the document. For example, the denoted page break ending page 2 occurs at the top of physical page 3. Applicant notes this because the Patent Office’s citations appear on face to refer to the denoted page breaks, but identify elements appearing under the denotation as occurring on the cited page. For example, the Patent Office opines that the end-to-end AAL2 connection identifier can be found on page 3. AAL2 is first mentioned on physical page 4 of the document and is also on denoted page 4, although the denotation of the end of page 4 takes place on physical page 5. Applicant relies on the physical page number in its analysis and requests that the Patent Office do the same for clarity.

In response to the rejection proper, Applicant notes that Holdrege is not enabling. On page 1 of the document, Holdrege indicates that it “is inappropriate to use Internet-Drafts as reference material or to cite them other than as ‘work in progress.’” The document goes on to state that “this work is incomplete and a draft.” The top of page 2 sets forth a mission statement, noting in effect that the document represents goals of the Internet Engineering Task Force that have not been achieved. This draft status is confirmed by the use of “shall” throughout the document. As in, “the Protocol shall support x.” However, the document never explains how this wishful thinking shall be implemented. Applicant believes that the self-admitted visionary nature of the reference is sufficient to establish its non-enablement. If the pioneers of the field that set the standards do not know how something would be done, then someone of ordinary skill in the art would not know how to do that thing. In this particular case, the document states that

"ATMF standards are working on an end-to-end AAL2 connection identifier as part of the AAL2 signaling set." Since the ATMF standards are still working on the identifier, that means that the ATMF standards have not determined how to make the identifier. Since the standard-making body does not know how to make the identifier, then someone of mere ordinary skill in the art would not know how to make the identifier. Since someone of ordinary skill in the art would not know how to make the identifier, the reference is non-enabling and may not be used as a reference in an anticipation analysis.

Even if the Patent Office ultimately concludes that the reference is enabled, the reference does not anticipate the pending claims because the reference does not show the communication of the EECID between the media gateway and the media gateway controller as recited in the claims. The reference indicates that the Protocol shall allow the possible adaptations to an ATM capable Gateway, but makes no reference to a media gateway controller. Specifically, even though the reference indicates that the Protocol shall allow the AAL2 connection identifier to be selected by the MG (media gateway) or imposed on the MG, there is no indication that a media gateway controller imposes this identifier on the MG or that the MG sends the identifier to a media gateway controller. Absent such a teaching, the reference cannot anticipate the claims. Since the Patent Office has not shown that the claims are anticipated, the claims are allowable.

Specifically, claim 1 recites that the method takes place in a media gateway. Further, the claim recites that the media gateway receives a command from an associated media gateway controller. The media gateway then sends the end-to-end call identifier (EECID) to the associated media gateway controller, and has other interaction with the media gateway controller. As noted above, while the reference indicates that the MG may select the AAL2 connection identifier, there is no indication that the identifier is sent to the media gateway controller as recited in the claim.

The Patent Office opines that this is taught by the ATM gateway MGC (media gateway controller) on page 3. Applicant has studied the reference thoroughly and cannot find any indication that the AAL2 connection identifier is sent to the ATM gateway MGC. The closest Applicant can find is the list of parameters passed from the MG to the MGC on page 5 of the reference, but even this list does not recite any identifier being passed to the MGC. If the Patent Office disagrees, Applicant requests that the Patent Office identify with greater particularity the

AAL2 connection identifier is passed to the MGC. Absent such proof, the element is not shown and the claim is not anticipated.

Claims 2-4 depend from claim 1 and are not anticipated at least for the same reasons.

Claim 5 recites the inverse of claim 1, but still recites both the media gateway controller and the media gateway, as well as the interactions therebetween. The Patent Office provides no separate analysis of the claim. As explained above, the reference does not indicate that the AAL2 connection identifier is passed between the media gateway and the media gateway controller, much less sent from the media gateway controller to the media gateway as recited in the claim. Since the element is not taught, the claim is not anticipated.

Claims 6-11 depend from claim 5 and are not anticipated at least for the same reasons.

Claims 12-31 recite similar sorts of elements. As explained above, the reference does not show the recited passing of the EECID back and forth from a media gateway to and from a media gateway controller. To this extent, the reference does not show all the claim elements and does not anticipate the claims.

Claims 4, 10, 15, and 22 deserve further mention. The Patent Office purports to reject these claims under 35 U.S.C. § 102(a). The Patent Office then rejects the claims under 35 U.S.C. § 103, admitting that Holdrege does not detail that the forward connection identifier is the same as that of a backward connection identifier. Since the Patent Office admits that Holdrege does not teach a claim element, claims 4, 10, 15, and 22 cannot be anticipated by Holdrege. Applicant requests withdrawal of the § 102(a) rejection of claims 4, 10, 15, and 22 on this basis.

Claims 4, 10, 15, and 22 were rejected under 35 U.S.C. § 103 as being unpatentable over Holdrege in view of Kline et al. (hereinafter "Kline"). Applicant respectfully traverses. For the Patent Office to combine references in an obviousness determination, the Patent Office must first articulate a motivation to combine the references, and second, the Patent Office must support that motivation with actual evidence. *In re Dembicza*k, 175 F.3d 994, 999 (Fed. Cir. 1999). Furthermore, even if the combination is proper, to establish obviousness, the Patent Office must still show where each and every element is shown in the combination. MPEP § 2143.03.

Initially Applicant traverses on the basis that the Patent Office has not supported the motivation to combine the references with the requisite actual evidence. Specifically, the Patent Office opines that it would be obvious to combine the references to "provide a simple and reliability [sic] to control the end-to-end connection over multimedia network." This assertion is

not supported by the actual evidence that the Federal Circuit mandates. Nor is there any evidence that the use of the same ID as the forward identifier and the backward identifier actually creates a simple and reliable system to control the connection. Since the motivation is not properly supported, the combination is improper. Since the combination is improper, the rejection based thereon is improper and the claims are allowable.

Even if the combination is proper, Applicant further traverses the rejection because the combination does not show the passage of the EECID between the media gateway and the media gateway controller as recited in the independent claims. As explained above, Holdrege does not show this claim element. Nothing in Kline cures this deficiency. Thus, in combination, the references do not teach or suggest the claim element, and the Patent Office has not established obviousness. Since the Patent Office has not established obviousness, the claims are allowable.

Applicant requests reconsideration of the rejections in light of the remarks presented herein. The reference does not show the recited the claim elements and cannot anticipate the claims. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

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